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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,753	07/15/2003	Tony Skuse	I-24641	7392
4859	7590	04/06/2005	EXAMINER	
MACMILLAN SOBANSKI & TODD, LLC ONE MARITIME PLAZA FOURTH FLOOR 720 WATER STREET TOLEDO, OH 43604-1619			NGUYEN, CHI Q	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/619,753	SKUSE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Chi Q Nguyen	3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 April 2004.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 28-42 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 28-42 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 25 January 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

This Office action is in response to the applicant's amendment filed on 1/25/2005.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard independent claims 28 and 35, the preambles were set forth an apparatus for illuminating an interior of a building through a roof of a building; and then the body of the claims cited as "said light transmissive panel having an upper surface that is substantially identical in shape to an upper surface of a roof covering and that lies in a plane defined by the roof covering". The claimed language is confusing and inconsistent because the examiner is unclear whether or not the applicant tried to claim the combination of an illuminating apparatus and a building roof?

In regard claims 33, 36 the cited limitation "including a light transmissive cover" is the same as claimed in claims 29, 40, respectively?

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on-sale in this country, more than one year prior to the date of application for patent in the United States.

As best understood, claims 28- are rejected under 35 U.S.C. 102(b) as being anticipated by Witzig (US 5,613,333).

In regard to claims 28, 35 Witzig teaches a plurality of roof tiles S that form a portion of a roof R covering a building, the roof tiles defining an upper surface having a shape and defining a plane (fig. 1). The assembly comprising a transparent light transmissive panel 5 including an opaque tile 13 having an opening 11 formed therethrough, and a light transmissive element 3 that extends across said opening 11, a light directing duct 70 that is supported on the light transmissive panel (figs. 5-6). Since Witzig teaches the similar structures as the applicant's claimed invention therefore it inherently capable performed the same functions.

In regard claims 29, 33, 36, 40, Witzig teaches the claimed invention wherein further including a light transmissive cover 38 that is supported on the light directing duct.

In regard claims 30, 32, 37, 39, Witzig teaches the claimed invention wherein said light transmissive panel further includes a housing 72 having a first end that is support on the opaque tile and a second end that supports the light transmitting duct.

In regard claim 42, Witzig teaches the claimed invention wherein the upper surface of the light transmissive panel is flush with the plane defined by the roof covering (figs. 1-2):

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34, 41, 31 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witzig (US 5,613,333).

In regard to claims 34 and 41, Witzig teaches the claimed invention as stated, which including the transmissive light panel 3 having a first or closed position to allow light into the room and a second or open position to allow ventilation of the room (see col. 3, lines 14-19). Witzig does not teach expressly the panel further comprises an air vent or apertures for allowing air from outside the roof to circulate through the duct. The examiner takes Official Notice the fact that the panel having apertures or the panel having operative open/close would have been performed the similar function such as circulating outside air into the building through the duct.

In regard claims 31 and 38, Witzig teaches the claimed invention wherein said first end of the housing 72 having a plurality of brackets 74 having outward projecting portion, which could serve as housing flanges. However, Witzig does not teach expressly the opaque tile having a recess so that the housing flange received within the recess. The examiner takes Official Notice the fact that the outward projecting portion secured to the frame 32 for supporting the opaque tile 13 would have been obvious functional equivalent such as securing and supporting the tile in place and align with the duct.

***Response to Arguments***

Applicant's arguments filed 1/25/2005 have been fully considered but they are not persuasive because the Witzig (US 5,613,333) reference teaches the similar structures as the applicant's claimed invention (see rejections above).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Graft, Schiedegger, Ayles, Bechtold, and Weisner teach skylight.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847, Mon-Thu (7:00-5:30), Fridays off or examiner's supervisor, Carl Friedman can be reached at (571) 272-6842. The examiner's right fax number is (571) 273-6847.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairdirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

CQN  
CN  
3/31/2005

  
Naoko Slack  
Primary Examiner